

MAIL STOP AF

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**In Re: Patent Application of Charles Eldering.**

Conf. No.: 2970 : Group Art Unit: 3622  
Appln. No.: 09/591,577 : Examiner: Yehdega Retta  
Filing Date: 09 June 2000 : Attorney Docket No.: T702-03

Title: Privacy Protected Advertising Systems

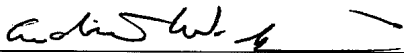
REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Applicant(s) request(s) review of the non-final rejection in the above-identified application, under the Pre-Appeal Brief Conference Program published on July 12, 2005. No amendments are being filed with this request.

- ☒ The review is requested for the reason(s) stated on the attached sheet(s).
- ☒ Notice of Appeal from the Examiner to the Board of Patent Appeals and Interferences is filed herewith.
- ☒ Extension of Time to and including October 20, 2008 (October 19 being a Sunday) is filed herewith.

Date: \_\_\_\_\_

*10/20/08*

  
\_\_\_\_\_  
Andrew W. Spicer, Esquire  
Reg. No. 57,420  
Carlineo, Spicer & Kee, LLC  
2003 South Easton Road, Suite 208  
Doylestown, PA 18901  
(267) 880-1720

Customer Number 81712

## **STATEMENT IN SUPPORT OF REQUEST FOR PRE-APPEAL BRIEF CONFERENCE**

Presently, claims 133-139 and 152-159 are pending in the application. This paper is being filed in support of the Request for Pre-Appeal Brief Conference submitted herewith. Details of the Examiner's rejections may be found in the Non-Final Office Action dated January 9, 2008 ("January Office Action") and the Non-Final Office Action dated June 19, 2008 ("June Office Action"). Discussion of the prior art references and the pending claims may be found in Applicants' Amendment dated October 31, 2007 ("October Amendment") and Applicants' Amendment dated March 14, 2008 ("March Amendment"), both of which are incorporated herein by reference. A summary of the August 5, 2008, Interview may be found in the Examiner's Interview Summary dated August 14, 2008 ("Examiner's Interview Summary"), and Applicants' Interview Summary submitted herewith ("Applicant's Interview Summary").

### ***No Prima Facie Obviousness***

The Examiner has rejected claims 133 – 139 and 152 – 159 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,463,585 to Hendricks *et al.* ("Hendricks") in view of U.S. Patent No. 6,120,300 to Ho *et al.* ("Ho") further in view of U.S. Patent No. 5,835,905 to Pirolli et al ("Pirolli") without establishing a *prima facie* case of obviousness. The Examiner's reasons for this rejection may be found at pages 2 - 6 of the June Office Action.

When making a rejection under 35 U.S.C. § 103, the prior art references, when combined, must teach or suggest all of the claim limitations. *See* MPEP 2143.03. The combination of Hendricks, Ho and Pirolli does not teach or suggest all of the features of Applicants' claims. Specifically, none of Hendricks, Ho, Pirolli, or the combination thereof teaches or suggests the use of psychological or sociological studies as recited in claim 133.

#### **1. Claim 133**

##### **a. Examiner Admits that Hendricks does not teach Psychological or Sociological Studies**

As explained in the March Amendment "Hendricks ... teaches nothing more than estimating a characteristic of one viewer based on 'test information generated from a statistically significant number of viewers.'" (March Amendment, p. 14). In the June Office Action, **the Examiner agrees with Applicants that Hendricks does not teach the use of psychological or sociological studies**, instead relying on Ho to teach this claimed element. As

argued by the Examiner, “**Hendricks does not disclose a rule that is based on a psychological or sociological study.** Examiner now provides Ho for the teaching of heuristic rules....” (June Office Action, p. 6).

b. The Examiner Fails to Allege that Ho Teaches Psychological or Sociological Studies

In an attempt to explain how Ho teaches psychological or sociological studies, the Examiner argues that “Ho used heuristic rule to determine or predict unknown user’s characteristics by *statistics* based on the *preference of similar students* (user behavior or action which a psychological or sociological study).” [sic] (Id., Examiner’s emphasis). This represents the entire portion of the June Office Action that discusses Ho’s alleged teaching of psychological or sociological studies. The problem, however, is that this quotation of the Examiner’s position does not even mention or imply Ho’s use of psychological or sociological studies. Furthermore, it is completely unclear what the Examiner’s statement actually means. The Examiner has been unable to give any explanation beyond affirmatively and arbitrarily declaring that “psychological or sociological study is interpreted to mean behavioral studies.” (Examiner’s Interview Summary) When Applicants specifically asked the Examiner how user behavior was equated to psychological or sociological studies, the Examiner was unable to provide any rationale, support or explanation. This is reflected in both the Examiner’s June Office Action and in the Examiner’s Interview Summary.

c. Ho Does Not Teach a Psychological or Sociological Study

The Examiner’s argument that, “user behavior or action which a psychological or sociological study,” does not describe a system which fills in the gap which Examiner admits is left by Hendricks. A close inspection of Ho describes what the Examiner repeatedly refers to as using “user behavior” to make a decision, but does not describe anything having to do with psychological or sociological studies. Ho states that the determination “can be heuristically determined by statistics based on the preferences of similar students.” (Ho, Col. 7, lns. 5 – 7) This means that the preferences of similar students are known through previous action of the system and a determination is accomplished based on the similarity. This does not describe a psychological or sociological study. First, there is no mention, suggestion or other notion which relates to anything psychological or sociological; Ho performs a simple one to one comparison of the preferences of similar students. Second, there is nothing in the art to suggest that user behavior is psychological or sociological. Finally, there is no implicit or explicit suggestion of any kind of study in Ho.

The Examiner seems to believe that anything “behavioral” constitutes a psychological or sociological study, as the Examiner repeatedly and without explanation incorporates “behavior” whenever referring to psychological or sociological study. As explained above, the Examiner has failed to explain the basis for such a construction. The Examiner is unable to explain this because there is no similarity between Ho and the psychological and sociological studies of claim 133. Applicants respectfully submit that the Examiner has failed to provide any cognizant rationale as to how Ho teaches this claimed subject matter, and that neither Ho nor Pirolli teaches the gap that the Examiner admits is left by Hendricks.

d. Ho does not Teach a Pre-defined Heuristic Rule

Additionally, Applicants note that even if Ho’s teaching of a behavioral element is somehow relevant to a psychological or sociological study, Ho still does not fill the gap which the Examiner admits is left by Hendricks. Claim 133 recites “pre-defined heuristic rules [which] have been developed based on at least one psychological or sociological study.” Ho teaches a list that “can be heuristically determined by statistics based on the preferences of similar students.” (Ho, Col. 7, lines 5 – 7). Applicants are uncertain how (a) Ho’s determination is a rule; and (b) how anything within this process is pre-defined. Ho’s description of a list which can be “heuristically determined” expresses a current action (i.e., a current determination) and not a “rule.” Furthermore, the heuristic determination occurs at the time of making the decision; therefore there is nothing “pre-defined” about the system. How can an action be pre-defined if it relies on a real-time heuristic determination?

**2. Claim 153**

a. The Examiner has Failed to Allege that All Elements of Claim 153 are Anticipated

The Examiner does not allege that all elements of independent claim 153 are taught by the combination, nor did the Examiner respond in any substantive way to the Applicants’ response to the Examiner’s previous rejection. As stated in the March Amendment “the Examiner fails to provide any explanation as to how Hendricks anticipates claim 153. The Examiner alleges that each element of independent claim 133 is taught, but fails to do the same for independent claim 153.” (March Amendment, pg. 15). Rather than providing a proper rejection to claim 153, in the June Office Action the Examiner again provides the same exact basis for rejecting claim 153 as the Examiner provides for claim 133. (June Non-Final Office Action, pg. 4). Specifically, the Examiner has applied the claim language of claim 133 to

claim 153. Unfortunately, the stated “rejection” of claim 153 does not even allege the prior art teaches “at least two types of analysis selected from the group consisting of logic tests, statistical estimates, self-learning, experiments, market studies, human knowledge and experience.” When specifically asked about this failure in the August 5th Interview, the Examiner was unable to respond. (See Applicant’s Interview Summary). In making a 103 rejection, the Examiner should show “the relevant teachings of the prior art relied upon.” (MPEP 706.02(j)). The MPEP continues that “it is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given a fair opportunity to reply.” *Id.* Furthermore, “in order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner **must** provide clear explanations of all action taken by the examiner during prosecution of an application,” respond to traverses made by the Applicant and otherwise be particularly point out where the art teaches the claimed subject matter. (MPEP 707.07(f); 37 CFR 1.104 (c)(2)). By continually failing to explain how the prior art teaches every element of claim 153, the Examiner has failed to meet the MPEP and the CFR requirements, even when Applicants explicitly and repeatedly requested such action.

**b. The Examiner Has Repeatedly Failed to Respond to the Applicants’ Arguments**

The Examiner has not responded to the argument set forth in the March Amendment. Specifically, Applicants argued that Ho teaches only one basis for heuristics, which differs significantly from that which is recited in claim 153. (See March Amendment, p. 18). This rationale has not changed, nor has it been responded to. The Examiner was specifically asked about this issue in the August 5, 2008, Interview, but was unable to respond in any coherent manner. In short, Applicants believe that the combination of Ho, Hendricks and Pirolli does not teach each and every element of claim 153, and applicants renew their arguments from the March Amendment. (See March Amendment, pgs. 16 – 19).

**3. There Is No Reason to Combine the References**

In *KSR*, the Court stated that it was “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *KSR Int’l Co. v. Teleflex Inc.* 127 S. Ct. 1727 (U.S. 2007). It is important to determine whether there was an “apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *See KSR*. The Court noted, “[t]o facilitate review, this analysis should be made explicit.” *See KSR*. Therefore, the Examiner must identify reasons why one of

ordinary skill in the art would have combined the prior art elements in the manner claimed: “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR, citing In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006).

The Examiner has failed to point to an “apparent reason to combine the known elements in” Hendricks, Ho or Pirolli, and instead relies on a vague unexplained notion that one of ordinary skill in the art would have a desirability to combine these references. In the March Amendment, Applicants explained that Ho would not have logically “commended itself to [the] inventor’s attention,” by explicitly discussing both Hendricks and Ho. (See March Amendment p. 17 – 18, *quoting* MPEP 2141.01(a)). Rather than responding substantively, the Examiner’s only response is that “Ho used heuristic rule to determine or predict unknown user’s characteristics by statistics based on the preference of similar students (user behavior or action which a psychological or sociological study).” (Non-Final Office Action, p.6). This is simply a restatement of the feature which the Examiner alleges is in Ho. However, the Examiner does not actually allege an “apparent reason to combine the known elements in the fashion claimed by the patent at issue,” as the Examiner is obligated to do under KSR. Merely pointing out the existence of particular teachings in one reference is not sufficient to establish that there would be a motivation to combine that reference with another. The burden is on the Examiner to provide a convincing line of reasoning, based on knowledge generally available to one of ordinary skill in the art, established scientific principles or legal precedent, that there would have been a motivation to combine Hendricks, Ho and Pirolli. *See* MPEP 2144. The Examiner has failed to meet this burden.

The Examiner has failed to show any reference which, alone or in combination, teaches each and every element of Independent claims 133 or 153. Therefore, the Examiner has not met the burden of *prima facie* obviousness. Accordingly, for the reasons detailed herein as well as in the October and March Amendments, independent claims 133 and 153, and all claims dependent thereon, are allowable over the combination of Hendricks, Ho and Pirolli.

Applicants respectfully submit that the Examiner's rejections have been previously overcome, and that the application, including claims 133-139 and 152-159, is in condition for allowance. Reconsideration and withdrawal of the Examiner's rejections and a Notice of Allowance are respectfully requested.